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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,439	11/16/2000	Shelton Louie	1205-002/JRD	5706
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IPSOLON, LLP (JRD) 111 SW COLUMBIA ST. SUITE 710 PORTLAND, OR 97201			EXAMINER  FRENEL, VANEL	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/715,439

**Applicant(s)**

LOUIE ET AL.

**Examiner**

Vanel Frenel

**Art Unit**

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 44-51 and 62-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 44-51 and 62-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/07 has been entered.

#### **Notice to Applicant**

2. This communication is in response to the RCE filed on 9/9/07. Claims 1-6, 44, 48-49 have been amended. Claims 7-43 and 52-61 have been cancelled. Claims 62-65 have been newly added. Claims 1-6, 44-51, 62-65 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 44-51 and 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (6,611,806) in view of Lasher et al (5,771,657) and further in view of Denenberg et al (6,464,142).

(A) As per claim 1, Harvey discloses a method for tracking physical location of prescription orders through a pharmacy having a plurality of physically spaced apart locations for filling and storing the prescription orders, the plurality of spaced apart locations being positioned along a workflow stream leading to a storage area with an array of compartments for storing filled prescription orders therein, said method including the following steps:

receiving a plural prescription orders at a first location upstream of the storage area (See Harvey, Col.12, lines 25-36);

operably securing a separate machine-readable tag to each prescription order upstream of said storage area, each said tag having a unique identifier that is readable by a tag reader in proximity to the tag regardless of its orientation relative to the tag reader (See Harvey, Col.4, lines 16-56);

associating the unique identifier of each tag with customer information stored in a computer system in association with the prescription order (See Harvey, Col.4, lines 4-31).

Harvey does not explicitly disclose that the method having moving each of the prescription orders by hand to one of the compartments in the array of compartments as a filled prescription order compartment having a corresponding compartment tag reader that is in communication with the computer system and is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag.

However, these features are known in the art, as evidenced by Lasher. In particular, Lasher suggests that the method having moving each of the prescription orders by hand to one of the compartments in the array of compartments as a filled prescription order compartment having a corresponding compartment tag reader that is in communication with the computer system and is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag (See Lasher, Col.13, lines 19-47; Col.15, lines 1-15) and

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Lasher within the system of Harvey with the motivation of providing a computer system called a Pharmacy Automation Computer (PAC) controls print, apply, and load stations (PAL stations), which print prescription labels, apply the labels to prescription bottles and load the labeled prescription bottles onto carriers (See Lasher, Col.1, lines 56-67).

Furthermore, as best understood, Harvey and Lasher do not explicitly disclose "prescriptions orders being moved between the plurality of spaced apart locations by one or more pharmacy workers by hand".

However, this feature is known in the art, as evidenced by Denenberg. In particular, Denenberg suggests that the method has been disclosed "prescriptions orders being moved between the plurality of spaced apart locations by one or more pharmacy workers by hand" (See Denenberg, Fig.2; Fig 8B; Col.10, lines 19-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Denenberg within the collective teachings of

Harvey and Lasher with the motivation of providing an efficient and accurate will call function by optimizing the storage of items and by electronically tracking the insertion and the removal of items (See Denenberg, Col.4, lines 1-4).

(B) As per claim 2, Lasher discloses the method for tracking physical location of prescription orders through a pharmacy of claim 1, further including the steps of: displaying on a computer system the compartment in which any selected prescription order is stored, thereby facilitating the easy location of said prescription order (See Lasher, Col.5, lines 1-20).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

(C) As per claim 3, Lasher discloses the method for tracking physical location of prescription orders through a pharmacy further including the steps of:

moving the prescription orders by hand to a second location within the pharmacy upstream of the storage area, the second location having a second location tag reader in communication with the computer system (See Lasher, Col.3, lines 31-67);

automatically detecting the presence of the prescription orders at the second location by reading the unique identifier of the remote tags with said second location tag reader regardless of the orientation of said tags (See Lasher, Col.5, lines 13-37); and,

automatically recording at the computer system the location of the prescription orders at said second location (See Lasher, Col.15, lines 44-67).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

(D) As per claim 4, Harvey discloses the method for tracking physical location of prescription orders through a pharmacy further including the steps of:

automatically collecting timing information about the amount of time each of the prescription orders remains at the second location (See Harvey, Col.3, lines 45-67);

storing said timing information into the computer system (See Harvey, Col.7, lines 52-67); and,

compiling workflow information based on the timing information (See Harvey, Col.10, lines 6-22).

(E) As per claim 5, Harvey discloses the method for tracking physical location of prescription orders through a pharmacy further including the step of:

associating the workflow information with a particular worker to evaluate worker efficiency (See Harvey, Col.12, lines 44-57).

(F) As per claim 6, Harvey discloses the method for tracking physical location of prescription orders through a pharmacy wherein said pharmacy is a retail pharmacy (See Harvey, Col.4, lines 16-28).

(G) As per claim 44, Harvey discloses said method comprising:

receiving a prescription order at a first location spaced apart from the storage area within the pharmacy (See Harvey, Col.8, lines 6-61);

operably securing a machine-readable tag to the prescription order, the machine-readable tag having a unique tag identifier readable when placed in proximity to each a tag reader regardless of orientation of the tag relative to the tag reader (See Harvey, Col.4, lines 16-56);

associating the machine-readable tag with customer information associated with the prescription order in the computer system (See Lasher, Col.3, lines 60-67 );  
filling the prescription order defining a filled prescription order (See Lasher, Col.31-59);

placing the filled prescription order and the machine-readable tag into one individually identified storage area of the plurality of individually identified storage areas without instructions from the computer system as to which individually identified storage area the filled prescription order and the remote machine-readable tag are to be placed into thereby defining a pharmacy worker selected storage area (See Lasher Col.3, lines 31-67 to Col.4, line 4);

reading the unique tag identifier of the tag within the pharmacy worker selected storage area with a tag reader that is associated with the pharmacy worker selected storage area, but not with any other individually identified storage areas in the array (See Lasher, Col.4, lines 54-67 to Col5, line 37);



retrieving the customer information from the computer system to determine the storage area identifier associated with the pharmacy worker selected storage area in which the customer's filled prescription order is located (See Lasher, Col.5, lines 1-37); and,

retrieving the filled prescription order by hand from the identified pharmacy worker selected storage area of the storage portion (See Lasher, Col.5, lines 1-37).

Harvey and Lasher do not explicitly disclose a method for ensuring that a pharmacy worker distributes the correct prescription order to a customer of the pharmacy, the pharmacy having a storage portion with an array of individually identified storage areas therein, each individually identified storage area having a unique visual identifier; providing the unique tag identifier and the storage area identifier for the pharmacy worker selected storage area to the computer system; the computer system correlating the customer information, unique tag identifier, and storage area identifier.

However, these features are known in the art, as evidenced by Denenberg. In particular, Denenberg suggests that a method for ensuring that a pharmacy worker distributes the correct prescription order to a customer of the pharmacy (See Denenberg, Col.2, lines 1-30), the pharmacy having a storage portion with an array of individually identified storage areas therein, each individually identified storage area having a unique visual identifier (See Denenberg, Col.10, lines 5-36; Col.11, lines 1-16); providing the unique tag identifier and the storage area identifier for the pharmacy worker selected storage area to the computer system (See Denenberg, Col.12, lines 61-67 to Col.13, line 2); the computer system correlating the customer information, unique

tag identifier, and storage area identifier (See Denenberg, Col.17, lines 1-24; Col.18, lines 58-57 to Col.19, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Denenberg within the collective teachings of Harvey and Lasher with the motivation of providing an efficient and accurate will call function by optimizing the storage of items and by electronically tracking the insertion and the removal of items (See Denenberg, Col.4, lines 1-4).

(H) As per claim 45, Denenberg discloses the method wherein said tag is a radio-frequency identification ("RFID") tag and said tag readers are RFID readers (See Denenberg, Col.18, lines 58-67 to Col.19, line 12).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

(I) As per claim 46, Lasher discloses the method wherein said storage area identifier is not related to information contained within the customer information (See Lasher, Col.1, lines 11-26).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

(J) As per claim 47, Lasher discloses the method wherein said storage area identifier is numeric (See Lasher, Col.4, lines 54-67).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

(K) As per claim 48, Harvey discloses the method further including: detecting the removal of the filled prescription order and its associated tag from the pharmacy worker selected storage area by the tag reader associated with the pharmacy worker selected storage area (See Harvey, Col.8, lines 6-42).

(L) As per claim 49, Denenberg discloses the method further including:  
monitoring with the computer system the time the filled prescription order and its associated tag remains within the pharmacy worker selected storage area (See Denenberg, Col.10, lines 28-53); and returning the filled prescription order to stock if the prescription order is not picked up within a predefined time limit (See Denenberg, Col.10, lines 28-53).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

(M) As per claim 50, Harvey discloses the method, further including placing a second filled prescription order with a second unique remote tag operably secured thereto within the pharmacy worker selected storage area such that the filled prescription order and the second filled prescription order concurrently occupy the same pharmacy worker selected storage area, and wherein the computer system

associates customer identifying information for the second filled prescription, the second prescription order and the storage identifier (See Harvey, Col.8, lines 19-61).

(N) As per claim 51, Harvey discloses the method, wherein the computer system detects the removal of the prescription order from the pharmacy selected storage area during the retrieving the prescription order step, and detects the continued presence of the second prescription order within the pharmacy selected storage area during the retrieving the prescription order step (See Harvey, Col.8, lines 19-61).

(O) Claim 62 substantially repeats the same limitations as in claim 1 and therefore, is rejected for the same reasons given above for this claim, and incorporated herein.

(P) As per claim 63, Lasher discloses the method for tracking physical location of prescription orders through a pharmacy of claim 62, further including the steps of: displaying on a computer system the compartment in which any selected prescription order was stored by hand, thereby facilitating the easy location of said prescription order by a pharmacy worker (See Lasher, Col.5, lines 1-20).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

(Q) Claim 64 substantially repeats the same limitations as in claim 3 and therefore, is rejected for the same reasons given above for this claim, and incorporated herein.

(R) As per claim 65, Denenberg discloses the method further including: detecting removal of a filled prescription order and its associated tag from a selected compartment in the storage area with the compartment tag reader corresponding to the selected compartment (See Denenberg, Fig.9, Col.18, lines 45-67 to Col.19, line 19, line 12).

The motivation for combining the respective teachings of Harvey, Lasher and Denenberg are as discussed in the rejection of claim 1 above, and incorporated herein.

### ***Response to Arguments***

5. Applicant's arguments filed on 9/9/07 with respect to claims 1-6, 44-51 and 62-65 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 9/9/07.

(A) At pages 8-20 of the 9/9/07 response, Applicant argues that the newly added features in the 9/9/07 amendment are not taught or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 9/9/07 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view the teachings of Harvey, Lasher and Denenberg based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office

Action and in the prior Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches pharmaceutical dispensing system (5,907,493), method and apparatus for reforming grouped items (5,794,213), system and method for drug management (6,021,392), method and system for tracking clustered items (6,496,806) and universal electronic identification tag (6,249,212).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zeender Ryan Florian can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

V.F

November 19, 2007